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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,485	01/23/2004	Eric J. Ruff	2916-5950US ()	7029
24247	7590	03/06/2007	EXAMINER	
TRASK BRITT			CHIN, PAUL T	
P.O. BOX 2550			ART UNIT	
SALT LAKE CITY, UT 84110			PAPER NUMBER	
			3652	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/06/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/763,485

Applicant(s)

RUFF ET AL.

Examiner

PAUL T. CHIN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Applicant's amendment filed November 20, 2006, and the arguments have been fully considered. With respect to claim 7, the argument is persuasive. Therefore, the rejection of claim 7 has been withdrawn. However, the arguments on other claims are not persuasive. Due to a new rejection, a non-final office action follows as below.

#### *Drawings*

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "a rounded stylus", "a placement tip", "tweezers", "a ball point", "an adhesive applicator", "a brush", "a scraper", "a cutting blade" "a poker", "a writing instrument", "a marking instrument" (claim 14), "two tools" (claims 15-17) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant recites "a grasping element associated with an end of the body and including an end for adhesion" in claim 1, lines 3. Applicant describes "a grasping element (50)" as a low viscosity and incompressible (see paragraph 38). However, applicant recites "a grasping element ....,and including an end for adhesion" in claim 1. It appears that the recitation is confusing as to how "the adhesive" has "an end". Claim 8 recites "a plunger including a tip positioned within the body" in line 2. The recited "tip" is unclear as to whether "the tip" refers to "the tip of a plunger" or to "the tip" as claimed in claim 4. Moreover, claim 9 recites "the tip" and it is unclear as to how "the tip" is inserted into a chamber of the body. Further, claim 14 recites the accessory tool and it is unclear as to how these accessory tool including "a rounded stylus", "a placement tip", "tweezers", "a ball point", "an adhesive applicator", "a brush", "a scraper", "a cutting blade" "a poker", "a writing instrument", "a marking instrument" (all not shown) are secured to one end of the body. Applicant also recites "a writing or marking instrument" and the recitation is vague and indefinite. It is unclear that applicant is claiming "a writing instrument" or "a marking instrument. Claims 15-17 also recite "the accessory tool including at least two tools" and the recitation is vague and indefinite. The recited "two tools" appears to be misleading because it is understood that the accessory tool has two working heads which is at the opposite each other. Note that applicant fails to define what two tools are.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5,8,9, and 11-19, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Den Hamer (3,797,875) (see PTO-892).

Den Hamer (3,797,875) shows a hand pick and place device comprising a body 1 (Fig. 1) having a chamber, a grasping element, an adhesive (Col. 2, lines 13-19), with an end of the body and an end for adhesion to a piece to be picked up, a tip (3) movable within the chamber, a plunger (5), and an interior fixed element (fig. 1) to limit the tip movement.

Re claims 3 and 4, figure 1 shows a tip (3,6) secured in the body and tube (2,9) wherein the tip could be differently positioned biased by a spring (13).

Re claim 5, Exhibit A (see next page) shows a tip-engagement element body and a body-engagement element includes a thread.

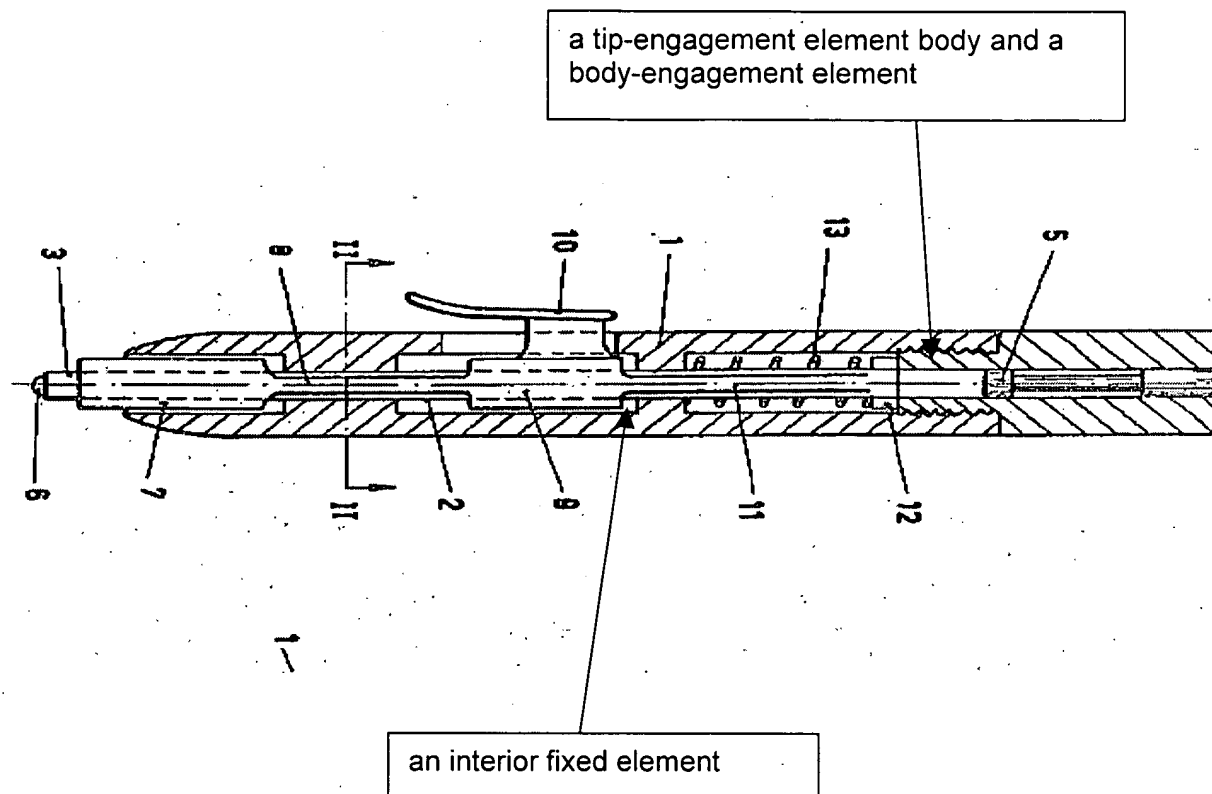
Re claim 6, figure 1 shows a piston (5), which can be considered as a plunger, positioned within the body (1).

Re claim 9, Exhibit A (see next page) shows an interior fixed element to limit the tip.

Re claims 11-13, figure 1 shows an accessory tool (4).

Re claim 14, the screw (4) could be used as a marking instrument.

Re claims 15-17, the screw (4) of Den Hamer (3,797,875), as best understood, could be considered as two working heads.

**Exhibit A**

7. Claims 1-5,8,9, and 11-19, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Mark (6,238,120).

Mark (6,238,120) discloses a tool comprising a body (23) having a chamber, a grasping element, a liquid adhesive (24) (Col. 1, lines 8-15), having an end of the body and an end for adhesion, a tip (15,17,20) (see Fig. 5) movable within the chamber, a plunger (37) (Fig. 7), and an interior fixed element (figs. 7 and 8) to limit the tip movement.

Re claims 3 and 4, figures 7 and 8 show a tip secured in the body and tube wherein the tip could be differently positioned biased by a spring (13).

Re claim 5, figures 7 and 8 show a tip-engagement element body and a body-engagement element includes a thread.

Re claim 6, figure 8 shows a plunger (37) positioned within the body (23).

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Re claim 9, figures 7 and 8 show an interior fixed element to limit the tip.

Re claims 11-14, figures 3 and 4 show an accessory tool (27,28), an adhesive applicator.

Re claims 15-17, figures 3 and 4 show two tools (27 and 28) to be removed.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6,7, and 10, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Den Hamer (3,797,875) in view of Palmer et al. (2003/0099746) (see PTO-892).

Den Hamer (3,797,875), as presented above, does not show a cap to cover. However, Palmer et al. (2003/0099746) teaches a cap (13) to cover the shaft. Accordingly, it would have been obvious to those skill in the art to provide a cap on the lower end of Hamer (3,797,875) as taught by Palmer et al. (2003/0099746) to secure the tip from damaging.

10. Claims 6,7, and 10, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mark (6,238,120) in view of Otake (5,388,726).

Mark (6,238,120), as presented above, does not show a cap to cover. However, Otake (5,388,726) teaches a cap (3) to cover the tip. Accordingly, it would have been obvious

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to those skilled in the art to provide a cap on the lower end of Mark (6,238,120) as taught by Otake (5,388,726) to secure the tip from damaging.

***Response to Arguments***

11. In response to applicant's argument that "den Hamer's disclosure to suitable adhesive element 6 materials is limited to beeswax and numerous synthetic rubber adhesives", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Note that the adhesive used in den Hamer's tool is capable of leaving no residue on a piece.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

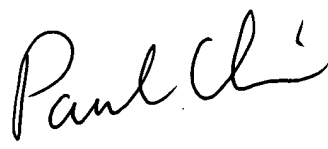
Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL T. CHIN whose telephone number is (571) 272-6922. The examiner can normally be reached on MON-THURS (7:30 -6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
PAUL T. CHIN  
Examiner  
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